

REMARKS

At the time of the Office Action dated February 20, 2003, claims 1-18 and 22-30 were pending in this application. Of those claims, claims 18 and 22-24 and 27-30 have been rejected and claims 1-17 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Applicants acknowledge, with appreciation, the Examiner's indication that claims 25-26 contain allowable subject matter. Claim 25 has been amended to be placed in independent form. Claim 18 has been amended to recite that a data processing device is configured to control valve pressure, flux viscosity, and flux spray pattern. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 18 and 22-24 and 27-30 are rejected under 35 U.S.C. § 102 for lack of novelty based upon Brownfield et al., U.S. Patent No. 6,399,902 (hereinafter Brownfield)

On pages two and three of the Office Action, the Examiner asserted that Brownfield discloses an apparatus corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that one having ordinary skill in the art would have recognized that the identically claimed invention is within the public domain.¹ Furthermore, the Examiner must also establish that the applied reference identically discloses each feature of the claimed invention.² As part of this analysis, the

¹ ATD Corporation v. Lydall, Inc., 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998); Electro Medical Systems S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

² In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not been discharged.

Claim 18 recites that the data processing device is configured to control valve pressure, flux viscosity, and flux spray pattern, and that the flux viscosity is controlled "in a range between about 10 centipoises and about 150 centipoises and the valve pressure for spraying the flux is controlled in a range between about 1.5 psi and about 30 psi." On page three of the statement of the rejection, in referring to this limitation and many of the other recited limitations with regard to the controller, the Examiner asserted:

it is the examiner's position that these limitations do not further limit the structural aspects of the apparatus. Furthermore the reference need only teach the structural aspects of the apparatus with those limitations capable of performing the functions indicated. Brownfield et al teaches the structural limitations required by the claims as indicated above.

By asserting that "these limitations do not further limit the structural aspects of the apparatus," the Examiner is therefore stating that the controller 101 of Brownfield, without modification, is configured to control, for example, valve pressure for spraying flux. The controller 101 of Brownfield, however, is not disclosed as structurally capable of controlling valve pressure for spraying flux. Thus, the Examiner's position must be that the control of valve pressure for spraying flux can be accomplished without any structure whatsoever. Applicants, however, respectfully disagree that pressure for controlling spraying flux can be accomplished without any structure. Furthermore, some structure is also required to control flux viscosity and flux spray pattern. As such, Applicants must also disagree with the Examiner's statements that:

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.

(a) "these limitations do not further limit the structural aspects of the apparatus and (b) "Brownfield et al teaches the structural limitations required by the claims as indicated above."

Furthermore, all of the limitations discussed by the Examiner in the first full paragraph on page three of the statement of the rejection with regard to the dependent claims also structurally limit the claimed invention. Thus, there are significant differences between Brownfield and the invention defined in claims 18, 22-24 and 27-30 that preclude a factual determination that Brownfield identically describes the claimed invention within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully solicit withdrawal of the rejection of claims 18, 22-24 and 27-30 under 35 U.S.C. § 102 for lack of novelty based upon Brownfield.

Claims 18 and 22-23 and 27-30 are rejected under 35 U.S.C. § 102 for lack of novelty based upon Hogan et al., U.S. Patent No. 6,265,017 (hereinafter Hogan)

On pages two and three of the Office Action, the Examiner asserted that Hogan discloses an apparatus corresponding to that claimed. This rejection is respectfully traversed.

As with Brownfield, the Examiner also argued that the limitation of a data processing device configured to control valve pressure, flux viscosity, and flux spray pattern and other limitations with regard to the data processing device do not structurally limit the claimed invention. The Examiner then stated that these features need not be disclosed by Hogan. In response, Applicants incorporate herein the arguments previously presented with regard to Brownfield, as these arguments also apply to the Examiner's rejection of the claims under Hogan. All of the limitations discussed by the Examiner structurally limit the claimed invention.

The Examiner is referred to the tens of thousands, if not hundreds of thousands, of issued patents in the electrical/computer arts that include device claims as to controlling devices or computers. As these issued patents evidence, the disclosure of a computer/controller configured to perform one function is not considered to be an identical disclosure of a computer/controller configured to perform a different function. Otherwise, the vast majority of these patents would have never issued.

Applicants, therefore, submit that significant differences exist between Brownfield and the invention defined in claims 18, 22-24 and 27-30 that preclude a factual determination that Brownfield identically describes the claimed invention within the meaning of 35 U.S.C. § 102. Thus, the withdrawal of the rejection of claims 18, 22-24 and 27-30 under 35 U.S.C. § 102 for lack of novelty based upon Brownfield is respectfully solicited.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

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